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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,214	03/29/2004	Krzysztof W. Pankiewicz	08841.105019 CON 2	3043
20786	7590	03/09/2006	EXAMINER	
KING & SPALDING LLP 191 PEACHTREE STREET, N.E. 45TH FLOOR ATLANTA, GA 30303-1763			DESAI, RITA J	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/812,214

**Applicant(s)**

PANKIEWICZ ET AL.

**Examiner**

Rita J. Desai

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

The claims 1-9 rejection under 35 USC 112 has been withdrawn since applicants have amended the claims to delete X as being NR.

The claims 1-3 and 8,9 rejection under 35 USC 103 over Lesiak et al 1997 has also been withdrawn since applicants arguments are convincing. Applicant's priority goes down to 2/13/1997 and reference abstract is up to July 1997.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

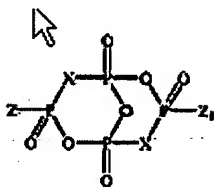
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glonek et al Full Anhydrization ... 1975.

In combination with WO 92/174488 Ingall et al

Or Zatorski et al Chemical Synthesis of Benzamide... 1996 May.

Applicants claims are drawn to compounds and a process of making these compound. of the formula as given in claim 1.



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The process uses a compound of the formula



and reacts it with a dehydrating carbodiimide agent.

### **Determination of the scope and content of the prior art (MPEP §2141.01)**

The Glonek reference teaches a process of making the methylene diphosponic acids using dicyclohexylcarbodiimide.

The different compounds are disclosed, especially see compound VII as given on page 1599.

Also see table I which gives the chemical shifts of each of the compounds.

The WO 92/17488 teaches the ATP analogs with bis phosphate group. The process uses the compounds of formula V on page 4 of the reference.

The Zatorski et al reference teaches the treatment of (isopropylidene –ribofuranosyl) benzamide

See the scheme 1 on page 1289 of the reference.

### **Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)**

The Glonek reference does not disclose the specific starting compounds as given in claim 7 to give the specific compounds as given in claim 8.

However the Na salts attached at the same position are shown.

The WO '488 teaches the groups and the motivation to use the specific starting material.

So does the Zatorski reference. Which clearly teaches the compounds but not the intermediate that would be formed as given by Glonek reference.

### **Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)**

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Since the process and mechanism of making the core is disclosed in the Glonek reference, one of skill in the art would use the different Z substitutions as taught by the WO '488 or the Zatorski reference to obtain the compounds of the invention.

*Conclusion*

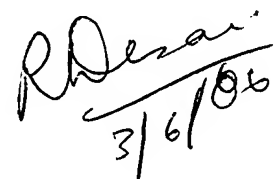
The claims 1-9 are not found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rita J. Desai  
Primary Examiner  
Art Unit 1625

Handwritten signature of Rita J. Desai and the date 3/6/06.

R.D.  
March 6<sup>th</sup> 2006.